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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/785,301 | 02/24/2004 | Shannon S. Stahl | 09820.261 | 2093 |

7590 01/04/2006

Intellectual Property Department
DEWITT ROSS & STEVENS S.C.
US Bank Building
800 Excelsior Drive Suite 401
Madison, WI 53717-1914

EXAMINER

KUMAR, SHAILENDRA

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

1621

DATE MAILED: 01/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|---------------------------------------|-------------------------------------|--|
| Office Action Summary | Application No. 10/785,301 | Applicant(s) STAHL ET AL. | |
| | Examiner SHAIENDRA -. KUMAR | Art Unit 1621 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
 4a) Of the above claim(s) 19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

This office action is in response to applicants' communication filed on 10/24/05.

Claims 1-19 are pending in this application. Claim 19 stand withdrawn from the consideration, being drawn to the non elected invention.

1. Applicant's election with traverse of Group I(claims 1-18) in the reply filed on 10/24/05 is acknowledged. The traversal is on the ground(s) that the office has not carried out the burden of providing any reason and/or example to support the conclusion that the claims of the restricted groups are in fact, distinct. This is not found persuasive because as set forth in office action of 7/22/05, it was explained expressly that the two invention are independent as a reference anticipating one of the invention may not render the other obvious under 35 USC 103. The applicants have not argued against the examiner's arguments.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 103

2. Claims 1-18 are again rejected under 35 U.S.C. 103(a) as being unpatentable over Bon et al(J. Org Chem., 1994), McKinney(US'974) and Krogh et al(US'498), all for the reasons of record, and further in view of Muhlebach et al(US 6,281,307).

Instant claims are directed to a process of amide metathesis and transamidation in an aromatic, aprotic solvent, using metal containing catalyst at a temperature of under 250°C.

Bon et, McKinney and Krogh et al are all explained in the office action dated 7/22/05. Briefly, Bon et al is teaching a trans amidation and metathesis reaction using

Lewis acid catalyst, see Table 1 and Table 2. The difference between the reference and herein claimed process is that the reference is not teaching other catalysts as claimed herein.

McKinney, Table line column 3-6, and Krogh et al, column 3, lines 45-50, are teaching that the catalyst as claimed herein, are old in the art for the amidation process.

The difference between the reference and herein claimed process, as amended now, is that the references are not teaching aromatic, aprotic solvent for the process.

Muhlebach et al is cited to show that in the process of trans amidation and metathesis, use of aromatic, aprotic solvent is old in the art, see, for example, column 32, lines 12-38.

It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to modify the process of Bon et al by using the catalyst of McKinney and Krogh et al, because the latter references are expressly teaching that various catalysts as claimed herein are old in the amidation process, or alternatively, use aromatic solvent as taught by Muhlebach et al, because the latter reference is expressly teaching that use of aprotic aromatic solvent is old in the art of transamidation and metathesis, with the reasonable expectation of achieving a successful process of amidation, absent evidence to the contrary.

Applicants' arguments were fully considered and were not found convincing in view of the newly cited art.

3. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHAILENDRA -. KUMAR whose telephone number is (571)272-0640. The examiner can normally be reached on Mon-Thur 8:00-5:30, Alt Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on (571)272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Shailendra - Kumar', with a circled 'S' at the beginning.

SHAIENDRA - KUMAR
Primary Examiner
Art Unit 1621

S.Kumar
12/30/05